UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/785,230
Filing Date: February 20, 2001
Appellant(s): KURAMOCHI, MAMIKO

MAILED

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Technology Center 2100

Mr. Michael E. Kondoudis
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 June 2007 appealing from the Office

action mailed 11 April 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6484178	Bence, Jr. et al.	11-2002
6,594,664	Estrada et al.	07-2003
JP 9282209	Yuichi	

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-22 and 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bence, Jr. et al. (Bence, Jr." 6, 484, I 78) in view of Estrada et al. ("Estrada" 6, 594,664).

As per claim 1, Bence, Jr. discloses a data processing system comprising:

a display control unit of implementing a display module for displaying at least one

format file containing a fixed format, and at least one data file containing item data to be

set to the fixed format (Bence, Jr., col. 4, lines 7-13 and Fig. 5);

a setting unit for setting the item data of the data file to the fixed format of the

format file in accordance with the specifying operation (Bence, Jr., col. 1, line 60 - col. 2,

lines 8, aligning the data contained in a given record, thus, creating a format

corresponding to the client's data format. . .this function serves to mass convert the

client's data records into a common data format")

Bence teaches facilitating the conversion data files into the common format by

prompting the operator to identify a client whose data is to be analyzed and formatted,

and optionally, to enter a specific name of a file containing the data by means of a drop-

down selection function as is well know in the art (col. 3, lines 60-67; col. 4, lines 7-13).

Bence does not explicitly teach firstly selects the data file and second drags the

selected data file to the format file.

Estrada, however, teaches "a specifying control unit implementing a specifying

module which performs two different operations, a first operation in which the specifying

module firstly selects the data file and second drags the selected data file to the format

file, and secondly drags the selected format file to the data file" as the drag and drop is

a specifying operation that instructs the system to convert a data file to a fix format

file/HTML file (col. 20, lines 46-67; col. 24, lines 23-27; col. 28, lines 20-26 and Fig. 16,

element 244).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because Estrada's

teaching would have allowed Bence's to provide speed and ease of use for the

operation because it processes two commands (i.e., select and drag-and-drop) in one

action as suggested by Estrada (col. 20, line 57).

As per claim 2, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 1, and further disclose said setting unit sets the item data to the fixed

format of the format file, and creates the plurality of files at one time (Bence, Jr. col. 2,

lines 18-33).

As per claim 3, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 1, and further disclose said setting unit sets the item data of the data

file to the fixed format of the format file by a form overlay function in accordance with the

specifying operation (Bence, Jr. Fig. 1, 5, 7, col. 2, lines 18-33).

As per claim 4, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 1, and further disclose a distinguishing unit of distinguishing between

file formats of the specified format tile and data file (Bence, Jr., Fig. 1, col. 2, lines 18-

33).

As per claim 5, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 4, and further disclose distinguishing unit distinguishes between the file formats of the format file and the data file on the basis of any one category of element among extensions, filenames and a file selection order (Bence, Figs. 4, 6A, 7, col. 7, line 65 - col. 8, line 15).

As per claim 6, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 1, and further disclose a print control unit of implementing a print module for printing contents of the item data of the data file which have been set to the fixed format of the format file in accordance with the specifying operation (Bence, Jr., Fig. 4, Printer Maker/Model).

As per claim 7, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 1, and further disclose said specifying control unit implements the specifying module for specifying the format file and the data file by a drag and drop function (Estrada, Fig. 16, element 244).

As per claim 8, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 1, and further disclose said setting unit sets the item data of the data file to the fixed format of the format file in accordance with the specifying operation of specifying the format file and the data file that are displayed in the form of display objects (Bence, Jr., Fig. 1, col. 2, lines 17-42).

Claims 9-12 and 16-19 are rejected on grounds corresponding to the reasons

given above for claims 1-4.

Claims 13- 15 and 20-22 are rejected on grounds corresponding to the reasons

given above for claims 6-8.

As per claim 24, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 2, and further teach said setting unit sets the item data of the data

file to the fixed format of the format file by a form overlay function in accordance with the

specifying operation (Bence, Jr., Fig. 1, 5, 7, col. 2, lines 18-49).

As per claim 25, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 2, and further teach distinguishing unit distinguishing between file

formats of the specified format file and data file (Bence, Jr., col. 2, lines 18-49).

As per claim 26, Bence, Jr. and Estrada teach all the claimed subject matters as

discussed in claim 2, and further teach a print control unit implementing a print module

printing contents of the item data of the data file which have been set to the fixed format

of the format file in accordance with the specifying operation (Bence, Jr., col. 6, lines

58-60).

Claim; 27, 32 and 37 are rejected on grounds corresponding to the reasons given above for claim 7.

As per claim 28, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 2, and further teach said setting unit sets the item data of the data file to the fixed format of the format file in accordance with the specifying operation of specifying the format file and the data file that are displayed in the form of display objects (Bence, Jr., col. 1, line 44 - col. 2, line 49).

Claims 29 and 34 are rejected on grounds corresponding to the reasons given above for claim 24.

Claims 30 and 35 are rejected on grounds corresponding to the reasons given above for claim 25.

Claims 31 and 36 are rejected on grounds corresponding to the reasons given above for claim 26.

Claims 33 and 38 are rejected on grounds corresponding to the reasons given above for claim 28.

3.   Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bence, Jr. et al.('Bence, Jr. 6,484,178) in view of Estrada et al. (Estrada 6,594,664) and further in view of Yuichi (JP 9282209).

As per claim 23, Bence, Jr. and Estrada teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing the format file and the data file are displayed as a list.

Yuichi, however, teaches displaying the files as a list (Yuichi, p 13, [Solving Means]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because Yuichi's teaching would have allowed Bence- Estrada's to enable the user to locate the desired file quickly and easily by display the files as a list.

(10) Response to Argument

Arguments (1)   Regarding claims 1-22 and 24-38

Appellant argues that the Office has not made out a prima facie case of obviousness in its rejection of claims 1-22 and 24-39 under U.S.C. 103(a) over U.S Patent No. 6,484,178 to Bence, Jr. et al. in view of U.S. patent No. 6,594,664 to Estrada et al. The Examiner's rejection ignores the expressly recited second operation (i.e., a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file) of the two-way specifying module. Consequently, the Examiner failed to provide evidence that suggest the two way specifying features of independent claims 1, 9, and 16 that were unpatentable over the cited art. For this reason, a prima facie case of obviousness has not been made.

In response to the preceding arguments, Examiner respectfully submits that

Estrada's teaches the claimed limitation: "a second operation in which the specifying

module firstly selects the format file and secondly drags the selected format file to the

data file" as the invention providing a system and method for drag and drop uploading

from a browser to a server of non-HTML files viewable as HTML files and editable as

non-HTML file and automatically converting a file while dragging the file to a new place

(col. 5, lines 40-46). Estrada further teaches QuickPlace offers a preset gallery of web

presentation formats (i.e., format file), from which the manager of room can choose and

then modify the one he chooses. A room 260 presentation includes a page, or work

area 261, an action bar 262, a side bar 263, a path bar 268, and persistent link 269.

After a user has created a QuickPlace form, to put this form into action, this or some

other *user creates a page using this form*. For example, an inventor may come into the

place where this form is stored and address the form by the name given by the author

(col. 20, lines 45-53; col. 24, lines 23-27; col. 28, lines 20-26). As such Estrada's preset

gallery of web presentation formats are equivalent with Appellant's invention of format

file. Once the user selected one of the forms from preset gallery of web presentation

formats (i.e., format file) to place it in a room. This action has transformed the selected

form to become an object (i.e., data file) within the room. It then follows that the above

object from Estrada is similar to that of Appellant's data file. Appellant's Specification

discloses that data file contains item data to be set to the fixed format and the format file

contains a fixed format (see Abstract and claim 1, first limitation 9). Examiner submits

that the combination of the applied prior arts teach the claimed limitations. As such, the

Office has met the prima facie case of obviousness in the rejection.

Arguments (2)   Regarding claims 1, 9, and 16

Appellant argues that the combination of U.S. Patent No. 6,484,178 to Bence, Jr

et al. and U.S. Patent No. 6,594,664 to Estrada et al. do not teach or suggest each and

every feature (i.e., two-way specifying features) of independent claims 1, 9, and 16.

In response to the preceding arguments, Examiner respectfully submits that

Estrada's teaches the two-way specifying feature – second way: "a second operation in

which the specifying module firstly selects the format file and secondly drags the

selected format file to the data file" as the invention providing a system and method for

drag and drop uploading from a browser to a server of non-HTML files viewable as

HTML files and editable as non-HTML file and automatically converting a file while

dragging the file to a new place (col. 5, lines 40-46). Estrada further teaches

QuickPlace offers a preset gallery of web presentation formats (i.e., format file), from

which the manager of room can choose and then modify the one he chooses. A room

260 presentation includes a page, or work area 261, an action bar 262, a side bar 263,

a path bar 268, and persistent link 269. After a user has created a QuickPlace form, to

put this form into action, this or some other *user creates a page using this form*. For

example, an inventor may come into the place where this form is stored and address

the form by the name given by the author (col. 20, lines 45-53; col. 24, lines 23-27; col.

28, lines 20-26). As such Estrada's preset gallery of web presentation formats are

equivalent with Appellant's invention of format file. Once the user selected one of the

forms from preset gallery of web presentation formats (i.e., format file) to place it in a

room. This action has transformed the selected form to become an object (i.e.,

Appellant's data file) within the room. As such, Estrada teaching's of placing the HTML

form within a room in a web page read-on Appellant's second operation (i.e., reverse

the file delivery) as the form after being place inside the room area has become an

object which can be interpreted as the data file as claimed.

Further, Appellant argues that Estrada does not teach or suggest selecting and

dragging a form to a non-HTML file and that the combination of Bence and Estrada is

deficient because Estrada fails to provide even a suggestion of a module which

performs the recited two different operations. Instead, Estrada merely provides one

way to convert data from the non-HTML file to HTML format by dragging a file to a form.

.. Stated another way, Estrada teaches selecting and delivering a non-HTML file to a

form, not vice versa. And any interpretation of secondary citation to Estrada as even

suggesting reversing the file delivery taught therein so that a form is deviled to a non-

HTML file is not reasonable in view of express teachings of that patent.

In response to Appellant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., selecting and dragging a form to a non-HTML file) are not recited in the rejected

claim(s). The claim recites "…a second operation in which the specifying module firstly

selects the format file and secondly drags the selected format file to the data file". As

pointed out from the above paragraph: "Once the user selected one of the forms from

preset gallery of web presentation formats to place it in a room. This action has

transformed the selected form to become an object (i.e., data file) within the room.

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

Finally, Appellant argues that Examiner's contention that, a suggestion to modify

Estrada et al. was unnecessary, is contrary to well settled law. Rather, there must be a

suggestion or motivation in the reference to do so. MPEP 2143.01.

In response to the preceding arguments, Examiner respectfully submits that in

the After-Final remarks filed on 11 August 2006, the Appellant argued that Estrada

teaches away from dragging and dropping the form to the data file.

In response to this argument, Examiner stated that "in order to

disqualify a reference based on the "teach away" reasoning, the

reference has to expressly suggest or discloses the so-called teach away

steps. Applicant's assertion can not be accepted if it is unsupported by a

valid evidence".

So the above response is to answer Applicant's arguments on the teach-away

step from the After-Final response; however, Appellant has re-stated the Examiner's

response in a different way (i.e., suggestion or motivation in the reference was

unnecessary). It is submitted that even if the Examiner did indicate that the suggestion

or motivation in the reference is unnecessary - this would have been proper also. The

MPEP § 2143.01[R-2] states:

"There are three possible sources for a motivation to combine references: the nature of

the problem to be solved, the teachings of the prior art, and <u>the knowledge of persons of</u>

<u>ordinary skill in the art.</u>" *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-

58 (Fed. Cir. 1998) (The combination of the references taught every element of the

claimed invention, however without a motivation to combine, a rejection based on a

prima facie case of obvious was held improper.). The level of skill in the art cannot be

relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l*

Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first

instance, it is necessary to ascertain whether or not the reference teachings would appear

to be sufficient for one of ordinary skill in the relevant art having the reference before him

to make the proposed substitution, combination, or other modification." *In re Linter*, 458

F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior

art to produce the claimed invention where there is some teaching, suggestion, or

motivation to do so found either explicitly or implicitly in the references themselves or in

the knowledge generally available to one of ordinary skill in the art. "The test for an

implicit showing is what the combined teachings, knowledge of one of ordinary skill in the

art, and the nature of the problem to be solved as a whole would have suggested to those

of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317

(Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430,

1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence

and making specific factual findings with respect to the motivation to combine

references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re

Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the

patent claimed underpinning a slumping building foundation using a screw anchor attached

to the foundation by a metal bracket. One prior art reference taught a screw anchor with

a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal

bracket. The court found motivation to combine the references to arrive at the claimed

invention in the "nature of the problem to be solved" because each reference was directed

"to precisely the same problem of underpinning slumping foundations." Id. at 1276, 69

USPQ2d at 1690. The court also rejected the notion that "an express written motivation

to combine must appear in prior art references...." Id. at 1276, 69 USPQ2d at 1690.

Based on the above, if the motivation to combine the references is one of the

three possible sources listed above, the obviousness of the case is established.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

Conclusion

Claims 1-38 are properly rejected under 35 U.S.C. § 103(a).

In light of the foregoing arguments, the Examiner respectfully requests that

Honorable Board of Appeals to sustain the rejections.

Respectfully submitted,

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